Supreme Court, U.S.
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No. 92-178

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1992

BB ASSET MANAGEMENT, INC., Transferee
Through BROWN BAG SOFTWARE, INC.
Petitioner

vs.

SYMANTEC CORPORATION and JOHN L. FRIEND,
an individual and dba SOFTWORKS DEVELOPMENT
Respondents

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

Opposition Brief of Respondent Symantec Corporation

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QUESTIONS PRESENTED

1. Did the Magistrate abuse her discretion by declining to permit plaintiff's in-house counsel to have immediate and unfettered access to a competitor's confidential documents where:

(a) plaintiff's outside attorneys had already had the confidential documents in their possession for six months,

(b) plaintiff offered no showing that the documents were relevant to any issues in the case,

(c) the Magistrate did NOT limit access to the documents "solely" because the plaintiff's attorney was its in-house counsel, but expressly considered all the facts and circumstances, and

(d) the Magistrate established a procedure whereby in-house counsel could seek access to particular confidential documents based on need, and plaintiff chose never to invoke the procedure?

2. Can plaintiff Brown Bag's central contention on the copyright issue — that the district court erred in (supposedly) failing to compare the two computer programs in their entireties — be addressed on the record here, when (1) Brown Bag itself asked the district court to perform the very element-by-element analysis which Brown Bag now contends was error and (2) Brown Bag never introduced, as part of its opposition to summary judgment, the entire programs which it now says the court should have considered?

3. Did the district court properly grant summary judgment against the claim that defendant Symantec's computer program copied the user interface of plaintiff's program where:

(a) the expressive aspects of the Symantec computer screen displays, viewed by the district court both individually and as a totality, were manifestly different from the Brown Bag screens, and

(b) all of the purported similarities listed by plaintiff itself were features that defendants were specifically licensed to use, were unprotectable under copyright, or represented demonstrably *different* expression?

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RULE INVOLVED IN THIS CASE

Rule 26(c) of Federal Rules of Civil Procedure:

> "*Protective Orders.* Upon motion by a party or by the person from whom discovery is sought, and for good cause shown, the court in which the action is pending or alternatively, on matters relating to a deposition, the court in the district where the deposition is to be taken may make any order which justice requires to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following: (1) that the discovery not be had; (2) that the discovery may be had only on specified terms and conditions, including a designation of the time or place; (3) that the discovery may be had only by a method of discovery other than that selected by the party seeking discovery; (4) that certain matters not be inquired into, or that the scope of the discovery be limited to certain matters; (5) that discovery be conducted with no one present except persons designated by the court; (6) that a deposition after being sealed be opened only by order of the court; (7) that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way; (8) that the parties simultaneously file specified documents or information enclosed in sealed envelopes to be opened as directed by the court.
>
> "If the motion for a protective order is denied in whole or in part, the court may, on such terms and conditions as are just, order that any party or person provide or permit discovery. The provisions of Rule 37(a)(4) apply to the award of expenses incurred in relation to the motion."

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INTRODUCTION

This case involves routine issues of no compelling importance beyond the immediate parties, and there is no reason for this Court to grant certiorari. Petitioner's first issue concerns a discovery dispute subject only to review for abuse of discretion, which the Ninth Circuit has already considered. Petitioner's second issue concerns the routine application of summary judgment standards to the evidence in a copyright dispute. The result is ruled by an assessment of the facts, and after careful consideration the Ninth Circuit confirmed the obvious result. No novel issue of law is presented. There is no reason for this Court to devote its scarce resources to yet another review of either the Magistrate's exercise of discretion or the factual basis for summary judgment.

STATEMENT OF THE CASE

A detailed Statement of the Case is required because petitioner Brown Bag has mischaracterized and distorted the record, notably by (1) falsely asserting that the Magistrate denied Brown Bag access to Symantec's confidential documents "solely" because Brown Bag's attorney was an in-house counsel and (2) misleadingly suggesting that the district court was at fault for (supposedly) failing to compare the entireties of the copyrighted computer program and the allegedly infringing work, when in fact Brown Bag never offered the entire programs into evidence. A careful review of the facts is also required because it discloses that even if Brown Bag's legal contentions had any merit, they could have no impact on the outcome since the undisputed facts show that the two programs are demonstrably different.[1]

I. Brown Bag's Complaint and Motion for Preliminary Injunction.

On June 8, 1988, Brown Bag Software filed a complaint for copyright infringement and related claims, accompanied by a motion for preliminary injunction, against Symantec and software developer John Friend. The complaint alleged that Symantec's and Friend's computer program GrandView infringed the copyright of Brown Bag's program PC-Outline, and the motion sought to bar Symantec from marketing GrandView.

Although Brown Bag's moving papers asserted that the "primary basis" for the motion was the supposed "substantial similarity in . . . audiovisual displays [the computer screens] between

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[1]Record references are as follows: "Docket No. _____" refer to the district court's docket sheet. "App. _____" refers to the appendices to Brown Bag's petition for certiorari. The Court of Appeals' opinion in this case is referred to as "9th Cir.Opn. [App. A]," the district court opinion granting summary judgment is referred to as "D.Ct.Opn. [App. B]," and the Magistrate's discovery ruling is referred to as "Mag.Ord. [App. C]."

"Resp. App." refers to Respondent's Appendix, one copy of which has been lodged with the Clerk. Respondent's Appendix consists of the transcript of the hearing on the discovery order challenged in Argument I of the petition; the transcript includes the Magistrate's oral ruling which supplements and clarifies the written Order on Symantec's Motion for a Protective Order entered March 8, 1989.

PC-Outline and GrandView" (Docket No. 4, p. 7), Brown Bag submitted neither the programs themselves nor any depictions of the computer screens. Defendants, however, provided a set of screen display pictures and other evidence. After comparing that evidence with Brown Bag's claims, the district court denied the motion. (Docket No. 33.)[2]

II. Subsequent Procedural Developments and the Discovery Dispute At Issue Here.

A. Magistrate Issues Seven Discovery Orders Against Brown Bag.

Following the denial of its preliminary injunction motion, Brown Bag persistently obstructed discovery, requiring the Magistrate to enter seven (7) discovery orders against Brown Bag. An order was even required that Brown Bag's president Sanford B. Schupper cease taking cellular telephone calls while being questioned during his deposition. (Docket Nos. 39, 41, 45, 47, 76, 113, 139.)

B. Withdrawal of Limbach firm and Appearance of In-House Counsel Brian J. Flynn.

On February 17, 1989 the district court granted the motion of Brown Bag's outside counsel to withdraw. On that same date, Brown Bag's newly hired in-house counsel Brian J. Flynn entered his appearance on behalf of Brown Bag. (Docket Nos. 89, 100.)

C. Dispute Over In-House Counsel's Access to Defendants' Confidential Source Code and Trade Secrets.

1. The Documents Sought by In-House Counsel.

At the outset of the litigation, defendants produced various confidential documents to Brown Bag's outside counsel under a Protective Order that barred Brown Bag or its employees from seeing the documents. (Docket No. 36; Resp. App. [Trans. of

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[2]Brown Bag admitted that it timed the filing of the suit on the eve of Symantec's anticipated initial public offering of shares in order to give Brown Bag a tactical advantage. Brown Bag's president Sanford B. Schupper told an uninvolved third party, the president of Paperback Software International, that Brown Bag was going to delay filing suit until Symantec's initial public offering was imminent because Brown Bag considered it "more advantageous to wait until 'closer to the offering.' " (Cook Decl. ¶¶ 3-5 [Docket No. 13].)

proceedings before Magistrate] pp. 7-9.) Immediately following Mr. Flynn's appearance in the case, he demanded that former outside counsel turn those confidential documents over to him.

The confidential documents included the computer source code to Symantec's computer program GrandView, as well as documents that revealed important future development plans for GrandView, product development practices, the identity of Symantec's valued "beta testers" and other trade secrets. As the Ninth Circuit pointed out below, the extreme sensitivity of these trade secrets and the potential damage to Symantec should they inadvertently be divulged to Brown Bag were undisputed. (9th Cir.Opn. [App. A] p. 3727.)

2. Defendant's Motion for Protective Order and the Magistrate's Findings of Fact.

Symantec and co-defendant Friend (the original developer of GrandView) promptly objected to Brown Bag obtaining access to their confidential documents, and moved for a protective order against disclosure to Brown Bag's in-house counsel Mr. Flynn. Contrary to petitioner's assertion that the Magistrate granted the protective order "solely" because Mr. Flynn was an in-house counsel (see, e.g., Certiorari Petition at pp. i, 5-6, 8, 13), the Magistrate had a full factual record before her and carefully considered all of the facts and circumstances before deciding the issue. Indeed, the parties submitted five declarations setting forth relevant facts and the Magistrate held a long and comprehensive evidentiary hearing on the motion. (Docket Nos. 91-97, 99; Resp. App. 1-52.)

(i) *Facts obtained by the Magistrate relevant to the risks of misuse of Symantec's trade secrets.* At the evidentiary hearing, the Magistrate closely questioned Brown Bag's in-house counsel in order "to look at, basically, what in-house counsel does." (Resp. App. 5, 27) The Magistrate found as a matter of fact, based on Mr. Flynn's own statements (Resp. App. 29-30), that Mr. Flynn "is the first and only in-house counsel for Brown Bag Software," that "[h]is responsibilities run the gamut of legal issues from personnel to intellectual property," that his "role is to advise management on all legal issues," and that he "is also the corporation's Human Resource (personnel) person." (Mag.Ord. [App. C].) Mr. Flynn himself described Brown Bag as a "very small company" with only "approximately 13 or 14 employees."

(Resp. App. 20.) He described his legal responsibilities as "quite broad," and acknowledged that they included "about any legal kind of problem that conceivably could come up in a small corporation." (Resp. App. 29.)

Mr. Flynn was unable to give any assurances regarding the limits of his responsibilities and activities because, having been so recently hired (Resp. App. 30), he did not yet know much about his own job. Indeed, even though he was also the personnel director, he could not give the Magistrate a breakdown of the functions of the different employees of Brown Bag because he was "not sure who the 13 or 14 people are or what they do." (Resp. App. 21.)

The Magistrate made a specific factual finding, based on the entire record, that Mr. Flynn "is so close to [Brown Bag] that the danger of inadvertant disclosure of information is impossible to control." (Mag.Ord. [App. C].) That factual finding was not challenged as clearly erroneous.

(ii) *The showing considered by the Magistrate concerning the relevance of the confidential documents.* At the hearing before the Magistrate, Symantec repeatedly pointed out that the confidential documents were irrelevant to the real issues in the case, and Brown Bag failed to offer any showing of relevance. (Resp. App. 14-17; 19-30.) The only theory of copyright infringement ever presented by Brown Bag was that Symantec's Grandview program copied the "look and feel" or "user interface" of Brown Bag's PC-Outline program; that is, that Symantec's program copied the computer screen displays and other features which the user perceives in working with the program.

Since the "user interface" of a program is not secret, a so-called "look and feel" claim can be assessed by "looking and feeling" — not by studying confidential documents and trade secrets. As the Ninth Circuit correctly held, "none of the trade secrets were themselves relevant to Brown Bag's 'look and feel' infringement claim, a claim dependent on comparison of the two published programs." (9th Cir.Opn. [App. A] p. 3729.)

Brown Bag now asserts, in this forum for the first time, that some of the documents could have been relevant to a claim that Symantec copied the computer source code underlying Brown Bag's program (Petition at p. 6). But Brown Bag never told the Magistrate that the documents might be relevant for that reason

nor did Brown Bag make any such argument to the Ninth Circuit. Indeed, Brown Bag's Rule 30(b)(6) witness acknowledged that Brown Bag was not alleging source code copying, a fact that was brought to the district court's attention during the summary judgment proceedings. (Docket No. 131, Exh. A.)

3. The Magistrate's Balanced Ruling.

Based on her factual findings and on the showing as to the documents' relevance, the Magistrate resolved the matter as follows: (1) The Magistrate decided that Mr. Flynn should not have immediate, unfettered access to the documents at issue. (Mag.Ord. [App. C].) (2) Instead, the Magistrate authorized Brown Bag's "independent consultant, legal or otherwise, to review and advise on issues involving the 'attorneys' eyes only' documents or the source code documents" and to report to Mr. Flynn concerning the results of that review. (Mag.Ord. [App. C].) (3) Finally and most importantly, the Magistrate established a procedure whereby Mr. Flynn could seek direct access to any relevant documents: If, following the review of the documents by Brown Bag's independent consultant, it is "the opinion of the outside consultant that in house counsel needs that material in order to pursue the litigation," Brown Bag could bring "a very specific request, item by item to the court, for the items that [Brown Bag] deem[s] to be necessary." (Resp. App. 48-49.)

Although Brown Bag did use an independent consultant to oppose summary judgment, Brown Bag never attempted to invoke the procedure established by the Magistrate. (9th Cir.Opn. [App. A] p. 3730.)

III. Defendants' Motion for Summary Judgment.

A. The Parties' Summary Judgment Submissions.

Following the close of discovery, Symantec and John Friend moved for summary judgment. The motion was supported by numerous declarations and exhibits, by Brown Bag's Rule 36 Admissions, and by admissions from the deposition of Brown Bag's Rule 30(b)(6) witness Sanford B. Schupper.

In opposition to summary judgment, Brown Bag submitted only the declarations of its expert Ronald Ogg and of Brown Bag president Stanford B. Schupper. (Docket No. 137.) Ogg's declaration included no exhibits and merely offered a list of purported similarities between GrandView and PC-Outline (*id.*,

¶ 5(a)-(q)) plus Ogg's opinion that the two programs were substantially similar. (*Id.*, ¶ 6). Schupper's declaration stated no independent facts, but attached as exhibits five pairs of photographs of the main working screens of the two programs, a section of the user manual for Symantec's program, and two newspaper articles on Symantec's GrandView.

Neither declaration included the entire programs at issue nor did Brown Bag submit a comprehensive set of photographs of all of the screen displays of the two programs. Thus, the only *facts* that Brown Bag proffered as a basis for denying the motion were those listed by Mr. Ogg, as illustrated in part by the handful of photos attached to Schupper's declaration.

B. Defendants' Motion to Strike the Declaration of Brown Bag's Expert.

Symantec and Friend moved to strike the Ogg declaration on the grounds that it was comprised of expert testimony inadmissible on the issue of substantial similarity, *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977), and that Brown Bag had concealed and failed to disclose Ogg's identity in response to interrogatories.

The district court stated that Ogg's declaration "contains expert opinion as to the similarity of the two programs, [and] will not be considered." Notwithstanding, the district court expressly ruled that it would apply the list of alleged similarities contained in Ogg's declaration in assessing Brown Bag's claims. (D.Ct.Opn. [App. B] p. 8 fn.3.) As a result, nothing that Ogg had to say (other than his conclusory assertion that the two programs were similar) was in fact excluded from the district court's consideration. Rather, the district court did precisely what Brown Bag asked — it considered whether the two programs were similar with respect to each of the discrete items specified in Ogg's list of purported similarities.

C. Scope of the District Court's Consideration of the Evidence.

As the Ninth Circuit pointed out, "there was no reason we should expect the district court to have made the analysis Brown Bag now requests" insofar as "no such evidence [of the entire program] was ever included as part of Brown Bag's opposition to Symantec's summary judgment motion" and since "the record

fails to include any evidence indicating that Brown Bag requested the district court to make this analysis." (9th Cir.Opn. [App. A] p. 3739.)

Nonetheless, in its effort to fairly consider Brown Bag's list of supposed similarities in context, the district court *sua sponte* directed the parties to provide in-court demonstrations of the two programs, and the court also examined the actual programs in chambers. (D.Ct.Opn. [App. B] p. 1.) Because of the two in-court demonstrations and the court's examination of the two programs, the district court was able to and in fact did go beyond Brown Bag's paper showing and consider the entirety of the two programs.

IV. The Facts That Were Before the District Court When It Ruled on Brown Bag's Copyright Claim.

A. Symantec's "Invention" of Computer Outlining.

This case involves several computer programs that perform outlining functions and that embody various expressions of the ideas inherent in computer outlining. It was the defendant Symantec which in 1983 first developed a practical and successful computer outlining program, the "seminal" outliner known as ThinkTank. (Docket No. 122.) Thereafter, Symantec "developed and marketed two more outlining programs, 'Ready' and 'MORE' . . . ." (9th Cir.Opn. [App. A] pp. 3722-23.)

B. The Development of PC-Outline and GrandView.

Defendant John L. Friend, an independent computer program designer, subsequently developed a new outlining program called "PC-Outline," which Friend acknowledged was "inspired by" Symantec's ThinkTank program; indeed, "Friend stated that he 'borrowed' several of ThinkTank's features for PC-Outline." (9th Cir.Opn. [App. A] p. 3723.) In 1987, Friend sold PC-Outline to Brown Bag's predecessor in interest as the result of a series of manipulations by the company's principal Sanford B. Schupper.[3]

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[3]The following facts were undisputed in the summary judgment proceedings: Schupper, as president of Brown Bag's predecessor Software Resources Group, Inc., concealed the fact that Software Resources was already in Chapter 11 bankruptcy proceedings, and induced Friend to grant Software Resources an exclusive license in exchange for a promise of minimum royalty payments of $250,000.

The agreement by which Brown Bag's predecessor obtained PC-Outline expressly contemplated that Friend would be free to develop other programs and the agreement explicitly licensed Friend to use some 129 pages of the PC-Outline computer source code in future computer programs that he might write. As discussed below, the source code which Friend was entitled to use includes "routines" that create virtually all of the screen display similarities which supposedly show that Symantec and Friend copied the user interface of PC-Outline.

Also in 1987, Friend developed the outlining program which came to be known as "GrandView," and sold the marketing rights to that program to Symantec. (Docket Nos. 130, 121.) Immediately after their agreement was signed, Symantec and Friend began a protracted process of consultations over modifying the user interface of GrandView, specifically to ensure that GrandView's user interface would be similar to that of Symantec's existing programs MORE and ThinkTank.[4]

Friend never received the promised payments. (Docket No. 130 ¶¶ 7-12.)

Subsequently Friend abandoned PC-Outline to Schupper in exchange for a nominal payment and the rights described below. By this time, Schupper had purchased some of the assets of his bankrupt Software Resources Group entity, including its rights to PC-Outline, which he transferred to a new corporation which came to be known as Brown Bag Software, Inc. In the fullness of time, Mr. Schupper also placed the new Brown Bag Software into bankruptcy (*id.*, ¶ 11). Interestingly, petitioner reports that an unnamed "secured creditor" has purchased PC-Outline from the second bankrupt Brown Bag entity, and transferred it to a new entity known as BB Asset Management, the petitioner herein.

[4]The systematic efforts to make the user interface of GrandView more "MORE-like" and "ThinkTank-like" were fully documented in contemporaneous communications between Friend and Symantec which state in part:

> ". . . These [changes in features] aren't great, but [will be] familiar to ThinkTank users."
>
> ". . . Suggest that these commands move to Reorganize menu to compare well to MORE/ThinkTank . . ."
>
> "I changed it to be like MORE." (Docket No. 121, Exhs. E and F.)

In part as a result of this developmental process, it was demonstrably the case, as the district court saw when it compared the programs, that the user interface of Symantec's GrandView program was similar to and based on Symantec's own program MORE, and was decidedly not similar to Brown Bag's PC-Outline program.

C. A Comparison of the User Interface of GrandView and PC-Outline.

The district court had before it the list of Mr. Ogg, Brown Bag's expert, representing supposed similarities between GrandView and PC-Outline, and the evidence that defendants placed before the Court. How did the programs compare? The district court engaged in a careful analysis and concluded that each of the features on Brown Bag's list represented either (1) an expressive feature that was in fact different between the two programs, (2) a feature that Friend was entitled to use under his license with Brown Bag, and/or (3) a feature unprotectable under copyright law. Brown Bag has not disputed any of these conclusions.

Now Brown Bag contends that the district court missed the forest for the trees. Brown Bag argues that even though many elements of the PC-Outline user interface were not copyrightable, the entirety could still add up to a unique copyrightable combination of elements, and the district court erred in not comparing the two works as a whole.

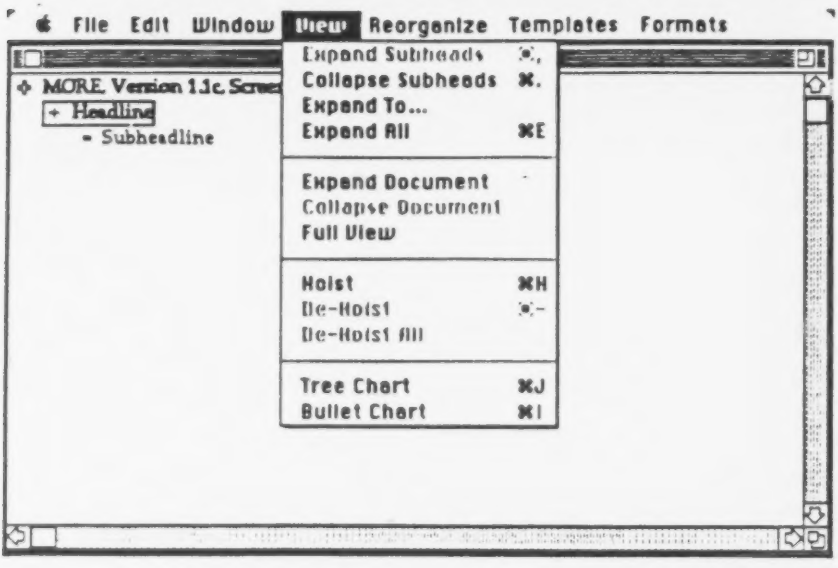
Leaving aside any legal issues, in so arguing Brown Bag ignores the critical and undisputed facts that were before the district court which showed that the two programs were *different* as to all of the categories of user interface features that Brown Bag itself pointed to. In light of Symantec's uncontested showing that the programs were comprehensively different in their user interface features, the argument that it was error not to have compared the entire works is frivolous. When the identified key elements of one program are overwhelmingly and systematically found to be different from the corresponding elements of another program, the entire works cannot be found to be similar.

1. The Menu Structures of the Two Programs Are Different.

The user of any outlining program can use the program to perform a variety of tasks, including reorganizing parts of the outline, editing, copying, printing, and saving. These functions can

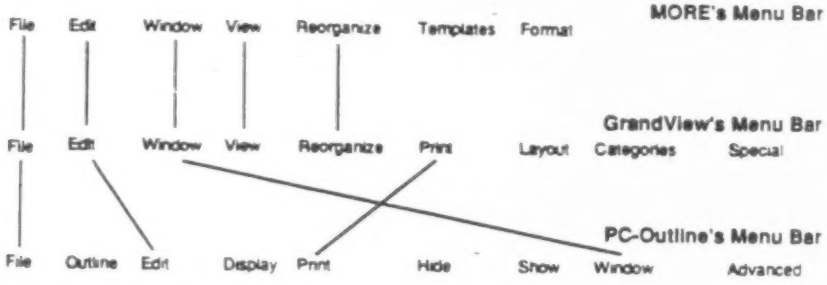
be invoked in a variety of means. (Docket Nos. 121, 122.) For example, special keys on the computer keyboard, known as "function keys," provide certain options. Functions can also be selected as choices from "menus" — lists of available commands and options. (*Id.*)

One common means of presenting the menus is to display a horizontal list of titles on a "Menu Bar" at the top line of the computer screen; the complete menu for each menu title can then be "pulled down" by using certain keys or a pointing device known as a "mouse." Below we depict one of the computer screen displays that could be seen in the course of using Symantec's earlier outlining program MORE. This "screen shot" shows the "Menu Bar" at the top ("File" through "Formats") and shows the "View" Menu pulled down. (Docket No. 121, Exh. A.)



Brown Bag's declarant Ogg asserted that there were similarities in the menus and menu bars of GrandView and PC-Outline, as well as in the titles and functions of the menus. (Docket No. 137.) But the actual menu screen depictions offered by defendants conclusively proved that the menus were different in structure, order and terminology, a point conceded by Brown Bag in its Rule 36 Admissions.

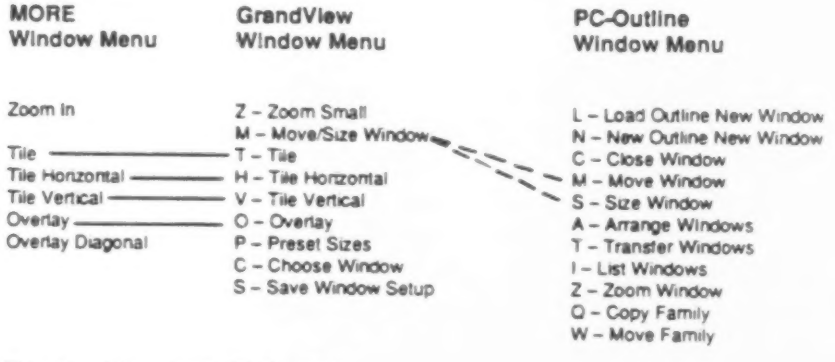
To illustrate, arranged below are the Menu Bars of Symantec's MORE, Symantec's GrandView and Brown Bag's PC-Outline, with lines drawn between the menu names that are the same:



(Docket No. 121, Exh. J.)

The name and order of the first five menus in MORE and GrandView are identical. Both the menu names and the order in which they appear are substantially different in GrandView and PC-Outline. (Docket No. 121, ¶¶ 33-34.) Moreover, all of the names common to PC-Outline and GrandView are standard industry terms in general use in many Macintosh and other programs. (Docket No. 130, ¶ 26(d); Docket No. 122.)

The individual Grandview and PC-Outline menus are even more obviously different. Note, for example, the menu choices of the "Window" menus for MORE, GrandView and PC-Outline shown below. (To facilitate a closer comparison, solid lines connect identical menu names; dashed lines connect arguably similar names.)



(Docket No. 121, Exh. K.)

Although the menus for the two Symantec programs MORE and GrandView are not identical, the geneology is obvious. Most

of the menu names in GrandView are copied from MORE, and the order of the menu functions has been maintained between the two. It is equally apparent that the Window menu in Brown Bag's program uses entirely different names. The remaining menus that were placed before the district court reflected even more strongly that the GrandView menu structure and terminology owe nothing to PC-Outline. (Docket No. 121, Exhs. G-K.)[5]

The lack of substantial similarity between GrandView's and PC-Outline's menus was admitted by Brown Bag in response to Symantec's Rule 36 Requests for Admissions. Plaintiff admitted that none of the command choices contained in six of Grandview's nine main menus were substantially similar to any of the command choices in the corresponding PC-Outline menus (Admissions 10, 23, 48, 53, 63 & 79 [Docket No. 126].) Plaintiff also admitted that most of the command choices in the remaining menus were not substantially similar. (Admissions 15-17, 31, 39.)[6]

2. The Opening Screens Are Similar Only in Ideas or Merged Expression and the Screens Look Completely Different.

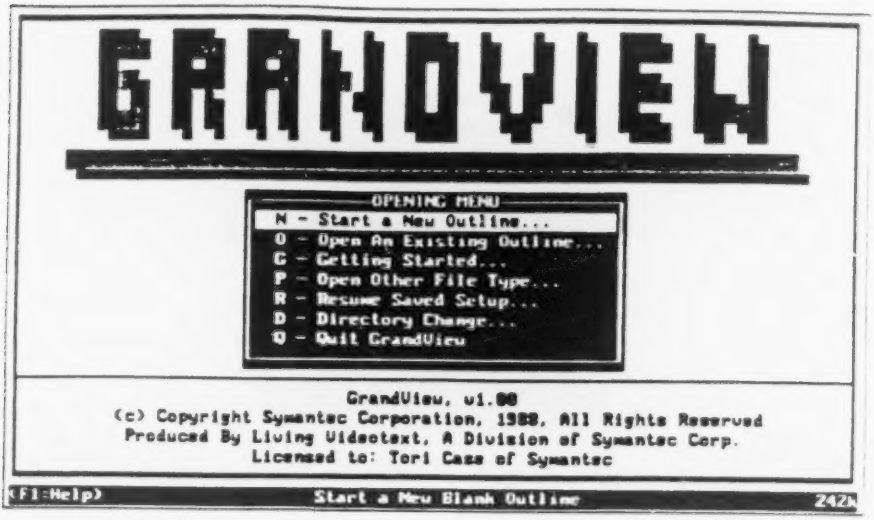
More than a third of the paragraphs of Mr. Ogg's declaration, listing purported similarities between GrandView and PC-Outline, concern the initial computer screens that include the opening menus. (Docket No. 137, ¶ 5(a)-(g).) The district court correctly found that none of the listed features was protectable. The court found, for example, that such features as calling an opening menu "Opening Menu" represented a merger of idea and expression, and that the need to access existing files was an idea inherent in an outlining program.

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[5]This is not to concede that either the order of the terms contained in the menus or the menu terminology are protectable under copyright. *See* 17 U.S.C. ¶ 102(b). But the simple fact is that the GrandView and PC-Outline menus are decidedly different.

[6]Brown Bag served no response to Symantec's Requests for Admissions (attached as Exh. E to Docket No. 126), consequently all of the Requests were automatically deemed admitted pursuant to the express terms of Rule 36. *Accord, United States v. Kasuboski*, 834 F.2d 1345, 1349 (7th Cir. 1987); *O'Bryant v. Allstate Ins. Co.*, 107 F.R.D. 45 (D. Conn. 1985). (Docket No. 127, pp. 18-22, 24-26.)

Although Brown Bag now faults the district court for supposedly ignoring the big picture, Brown Bag conveniently omitted from its evidentiary showing any picture of those opening screens. But Symantec submitted "screen shots" of the two, shown below. (Docket No. 145, Exh. A.) No wonder Brown Bag chose not to provide the district court with the entire works. A glance confirms that in fact the opening screens viewed as a whole are utterly different.





3. The Color Scheme of the Programs Is Uncopyrightable, Functional, and Largely Different.

Mr. Ogg asserted, as another purported similarity, that the main editing screens of the two programs have similar color schemes. Although the district court correctly held color to be unprotectable and functional in character (D.Ct.Opn. [App. B] p. 12), it was as a matter of fact undisputed that most of the colors used in the two programs are different. Of the 44 "default" color selections made by the GrandView program, fewer than 10 (less than one quarter) are the same as the color selections in PC-Outline. (Docket No. 130.)

4. The Special Keystroke Combinations and Procedures are Not Protectable and Are Different.

Mr. Ogg also made the conclusory assertion that the procedures or keystrokes used for performing various functions are similar between the two programs. (Docket No. 137, ¶ 5.) But a systematic examination of all of the keystroke short-cuts (used to perform functions without going through the menus) revealed that of 211 such keystrokes, there are only 25 (11 percent) which are common to the two programs, and 14 of those are standard in the industry. (Docket No. 130, ¶ 30 & Exh. D); Brown Bag Admission No. 76 (Docket No. 126). Similarly, the specific procedures for performing common outlining tasks are different. (Docket No. 130, ¶ 26(i)-(1).)[7]

5. The Main Editing Screens of the Two Programs Are Not Copyrightable and Any Similarities Were Licensed to Friend.

Although many of the paragraphs of Ogg's list of purported similarities between GrandView and PC-Outline concern the appearance of the main editing screens of the two programs (Docket No. 137, ¶ 5), Brown Bag basically admits in its certiorari petition that those computer screens are merely uncopyrightable blank forms: "[O]utlining programs, such as PC-Outline," Brown Bag itself states, "begin with essentially blank screens, and

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[7]It is undisputed in this action that keystroke patterns are not protectable under copyright in light of 17 U.S.C. § 102(b): "In no case does copyright protection . . . extend to any . . . procedure, process, [or] method of operation . . . ."

the users create . . . outlines in which the users input their own information." (Petition at p. 28.) Such forms, it is long established, are not copyrightable. *Baker v. Selden*, 101 U.S. 99, 107 (1880) ("blank account-books are not the subject of copyright").

Moreover, the main working screen of GrandView is nothing more than the sum of the screen features that Friend was entitled to use under his license with Brown Bag. The agreement that transferred PC-Outline to Brown Bag expressly licensed Friend to use 129 pages of computer source code, code that generates the very screen features that Brown Bag claims are infringed. (Docket No. 165.) Brown Bag never disputed below that Friend was specifically entitled to create new programs using source code that would (1) draw a menu bar at the top of the screen, (2) draw a menu bar with one of the options highlighted in reverse video, (3) display a pull down menu, (4) permit the user to select an item on the menu by using the first letter of the menu item, (5) highlight a currently selected menu option, (6) draw a single-line bordered box around menus and windows, and (7) draw a message line at the bottom of the screen. (*Id.*) A moment's perusal of the main editing screens (Docket No. 121, Exh. L; following page) confirms that these features comprise virtually the entire display and that the screens are indeed blank forms.

The only elements of the main working screens that were not created by using Friend's licensed code were the content of the menu bar and message line, which are *different* in the two programs, and certain details of the screen display which are also *different*. (Docket No. 121.)

* * *

In sum: Although Brown Bag asserts that the district court erred by (supposedly) not comparing the programs as a whole, as to all of the elements addressed by Brown Bag itself the two programs are overwhelmingly and undisputedly different.

GrandView, Version 1.0, 6/19/1988



PC Outline Version 3.38 6/19/88



REASONS FOR DENYING THE WRIT

I.

BROWN BAG'S CLAIM THAT IT HAS A CONSTITUTIONAL RIGHT TO HAVE ITS IN-HOUSE COUNSEL EXAMINE A COMPETITOR'S TRADE SECRETS IS FRIVOLOUS.

Petitioner Brown Bag contends that its constitutional right to choice of counsel was violated because the Magistrate purportedly denied Brown Bag's in-house counsel access to Symantec's confidential documents, supposedly based "solely" on the fact that Brown Bag's attorney was an in-house counsel.

Brown Bag's claim rests on two blatant falsehoods. First, the Magistrate did not bar Brown Bag from having access to confidential documents, but only required Brown Bag first to use a reasonable procedure set forth by the Magistrate. Second, the Magistrate's decision did not rest only on the fact that Mr. Flynn was in-house counsel. In bold contrast to Brown Bag's repeated, disingenuous assertion that the Magistrate's decision rested "solely" on Mr. Flynn's status as an in-house attorney (see, e.g., Petition at pp. i, 5-6, 8, 13), the record unequivocally shows that the Magistrate examined *all* of the facts and circumstances connected with Mr. Flynn's role at Brown Bag. The Magistrate only rejected Mr. Flynn's demand for unfettered and unconditional access to Symantec's secrets after expressly finding that "*under the circumstances of this case* in-house counsel is so close to the party that the danger of inadvertent disclosure of information is impossible to control." (Mag.Ord. [App. C] p. 2, emphasis added.)

Brown Bag offers no authority in support of its assertion that its constitutional rights were violated. Brown Bag's argument is frivolous because on the actual facts of this case it is impossible to argue that the Magistrate's decision represents reversible error under the relevant standard, abuse of discretion.

A. The Constitution Was Not Violated by the Magistrate's Exercise of Discretion.

It is apparently Brown Bag's position that the constitutional right to counsel is offended by any limitations on in-house counsel's "right" to review confidential documents provided by its competitors.

Nonsense. Nothing in the Constitution gives a litigant's employees the right to possess another party's trade secrets and proprietary information, and no case has ever held that it does. The fact that a plaintiff chooses to use its in-house lawyer as its sole counsel of record does not give it an absolute right to obtain its competitor's confidential documents. Rather, as Rule 26(c) of the Federal Rules of Civil Procedure anticipates, it is well within a court's legitimate power and discretion to "make any order which justice requires to protect a party [from] oppression . . . including [an order] that a trade secret or other confidential research, development, or commercial information not be disclosed or be disclosed only in a designated way . . ."

The reasonable procedures that the Magistrate imposed as a condition for Brown Bag's in-house counsel to obtain access to Symantec's confidential information were plainly not beyond the constitutional powers of the district court and did not violate Brown Bag's fundamental rights.

In reality, a district court's order limiting the disclosure of confidential documents implicates no constitutional issues, and, it is well-established, is simply reviewed for abuse of discretion.[8]

B. Brown Bag Waived The Issue By Not Invoking the Procedure to Gain Access to the Documents and Not Asserting the Issue in Opposing Summary Judgment.

Under the Magistrate's order, it was incumbent on Brown Bag to have an independent consultant review the confidential documents if Brown Bag's in-house counsel wanted to pursue the issue. Brown Bag did obtain the services of an (apparently) independent computer consultant and submitted his declaration in opposition to summary judgment. (Docket No. 137.) But Brown Bag failed to use its consultant to determine whether any

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[8] *F.T.C. v. Exxon Corp.*, 636 F.2d 1336, 1349 (D.C. Cir. 1980) (denial of access to confidential documents by in-house counsel affirmed on basis of abuse of discretion standard); *KL Group v. Case & Lynch*, 829 F.2d 909, 915 (9th Cir. 1987) ("We review the district court's grant of a protective order relating to discovery for abuse of discretion"); *Hartley Pen Co. v. U.S. District Court*, 287 F.2d 324, 330, 331 (9th Cir. 1961) (district court's decision to require disclosure of trade secret subject to abuse of discretion standard; held an abuse of discretion where insufficient showing of relevance and necessity).

confidential documents were relevant, failed to invoke the procedures specified by the Magistrate for re-visiting the issue, failed to assert lack of access to confidential documents as a ground for opposing summary judgment, and failed to file a Rule 56(f) affidavit asking for more time in which to investigate the documents. Brown Bag thereby waived the issue. *Adkins v. E. I. Du Pont De Nemours & Co.*, 181 F.2d 642 (10th Cir. 1950) (after discovery responses stayed, plaintiff who failed to raise issue of discovery stay again at time of summary judgment motion barred from raising issue on appeal).[9]

C. Brown Bag Misrepresents the Magistrate's Order.

Brown Bag's entire argument rests on the false premise that the Magistrate's protective order "denied Brown Bag's trial counsel access to the confidential material . . . solely because he was in-house counsel." (Petition at pp. 5-6.) But Magistrate Trumbull's decision in fact rested on the very multi-factor, case-by-case balancing test mandated by *U.S. Steel Corp. v. U. S.*, 730 F.2d 1465 (Fed.Cir. 1984), which Brown Bag relies on.[10] In affirming, the Ninth Circuit expressly adopted a similar balancing test, and observed that "[t]he record belies [Brown Bag's] contention" that the magistrate failed to perform the required factual inquiry

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[9]As the Ninth Circuit stressed in this case, "Brown Bag failed to demonstrate how the protective order actually could have or did prejudice its case. Brown Bag never attempted to implement the independent consultant method of access to the trade secrets and never argued the method was unduly burdensome. Instead, Brown Bag alleged its unfettered right to the discovery documents and complained of arbitrary discrimination against in-house counsel. Brown Bag's arguments are unsubstantiated. We therefore hold that the [district] court did not abuse its discretion . . ." (9th Cir.Opn. [App. A] p. 3729-30.)

[10]*Accord, Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1483 (Fed.Cir. 1983) (upholding denial of access to in-house counsel; "three-part balancing test" used); *F.T.C. v. Exxon Corp.*, 636 F.2d 1336, 1349 (D.C. Cir. 1980) (emphasizing "facts of this case"; denying in-house counsel access); *A. Hirsch, Inc. v. U.S.*, 657 F.Supp. 1297, 1303 (C.I.T. 1987) (weighing "factual circumstances surrounding" in-house counsel; applies balancing test and denies access because risk of disclosure not *de minimis*).

"before crafting the protective order in this case." (9th Cir.Opn. [App. A] p. 3727.)

A moment's perusal of the Order at issue confirms that the Ninth Circuit was entirely correct — the Magistrate did not decide the issue "solely" on the basis that Mr. Flynn was in-house counsel. The Order summarizes the Magistrate's particular factual findings underlying the decision (findings which go far beyond the mere fact of Mr. Flynn's in-house status), and expressly recites that "*[u]nder the circumstances of this case* in-house counsel is so close to the party that the danger of inadvertent disclosure of information is impossible to control." (Mag.Ord. [App. C] p. 2, emphasis added.)

The transcript of the Hearing on this issue (Resp. App. 27) makes it even clearer that the decision on in-house counsel's claim to confidential documents was based upon a thorough examination of the specific functions and duties of in-house counsel.

D. The Factual Record Unambiguously Supports the Magistrate's Exercise of Discretion.

1. There Was a Strong Risk of Inadvertent Disclosure or Misuse of Confidential Information.

The Magistrate specifically found, based on Mr. Flynn's own statements (Resp. App. 20-21, 29-30), that Mr. Flynn's "responsibilities [as Brown Bag's in-house counsel and personnel director] run the gamut of legal issues from personnel to intellectual property" and that his "role is to advise management on all legal issues." (Mag.Ord. [App. C] p. 2.) The company was extremely small, and Mr. Flynn's role, vague but potentially all-encompassing. The Magistrate reached the obviously reasonable conclusion that the practices of so small a company would be informal and fluid, and that it would be impossible to insulate Mr. Flynn from decisions in which defendants' confidential information could provide an important competitive advantage to Brown Bag.

Courts have frequently denied in-house counsel access to the confidential documents of a competitor. *F.T.C. v. Exxon Corp.*, 636 F.2d 1336, 1350 (D.C. Cir. 1980); *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1483 (Fed.Cir. 1983); *A. Hirsh, Inc. v. U.S.*, 657 F.Supp. 1297, 1304 (C.I.T.

1987). In-house counsel like Mr. Flynn advise on corporate planning and strategy, and, having learned their competitor's marketing strategies, new product development plans and trade secrets, cannot provide advice without making conscious or unconscious use of that information. As the Ninth Circuit sagely observed, the Magistrate had to consider "not only whether [Symantec's confidential] documents could be locked up in cabinets, but also whether Brown Bag's counsel could lock up trade secrets in his mind, safe from inadvertent disclosure to his employer once he had read the documents." (9th Cir.Opn. [App. A] p. 3728.)

"It is very difficult for the human mind to compartmentalize and selectively suppress information once learned, no matter how well-intentioned the effort may be to do so." *Exxon,* 636 F.2d at 1350. The risk was acute in this case because Mr. Flynn's duties were neither segregated nor isolated. "[I]n a small corporation where insulation of one department from another is insignificant, if it exists at all, there remains a justified concern that disclosure to [in-house counsel] would place him in the unnatural and unremitting strain of having to exercise constant self-censorship in his normal working relations." *A. Hirsh*, 657 F.Supp. at 1304. Mr. Flynn was not in an insulated department of a big company. He *was* the entire legal "department" — and he doubled as the Human Resources Manager.

Based on the entire record, the court found that Mr. Flynn was "so close to the party that the danger of inadvertant disclosure of information is impossible to control." (Mag.Ord. [App. C] p. 4.) That factual finding conclusion is unassailable and has not been challenged as clearly erroneous. The Magistrate's decision to limit Mr. Flynn's access initially to an independent consultant, pending a particularized showing of relevance, was plainly not an abuse of discretion. Rather, it was a measured response, carefully balancing the competing interests.

2. The Confidential Documents Are in Fact Utterly Irrelevant.

There is a simple explanation for Brown Bag's failure to have its independent consultant review the documents. Brown Bag knew they were completely irrelevant. This case involves a claim that the user interface of GrandView is substantially similar to

that of PC-Outline. The user interface is not secret, and a "look and feel" claim can be assessed by examination of the published works, not by studying trade secrets or confidential documents. Similarly, Symantec's marketing plans, the identity of its "beta" testers, and the appearance of earlier unpublished versions of the program are irrelevant to the real issues.

Now, as an afterthought not raised before the Magistrate or the Ninth Circuit, Brown Bag dreams up a new theory — that the confidential documents bear on a hypothetical claim that the computer code underlying Symantec's program was copied from Brown Bag's program. Obviously, it was not an abuse of discretion for the Magistrate to fail to consider such an argument when it was never placed before her.

Brown Bag's failure to make any meaningful offer concerning the relevance of Symantec's confidential documents is particularly telling because Brown Bag's outside attorneys had the confidential documents in their possession for six months. The Magistrate's Order provided — and Brown Bag spurned — yet another practical means of determining whether the documents were relevant. On this record, Brown Bag can show neither that the Magistrate's order was improper nor that the order could have had any impact whatsoever on the outcome.

In conclusion: The Magistrate patiently explored all of the facts and circumstances before issuing her order. The risk of inadvertant disclosure was high. The documents were irrelevant. The Magistrate's carefully crafted decision was not an abuse of discretion.

II.

THE COURT CANNOT ON THIS RECORD REACH PETITIONER'S COPYRIGHT CONTENTIONS.

Petitioner's only substantive argument on appeal and here is its assertion that the trial court committed reversible error by failing to compare *as a whole* the plaintiff's work with Symantec's work. But, as the Ninth Circuit indicated, there can be no reversible error — and the issue cannot be reached — where petitioner itself invited the very analytic dissection which it now condemns; where petitioner never put the entire works before the district court; and

where petitioner never even asked the district court to perform the analysis it now requests. (9th Cir.Opn. [App. A] pp. 3737, 3739.)

A. Brown Bag Waived any Claim That The District Court Erred in Not Comparing The Works as Wholes.

The gravamen of plaintiff's copyright argument is now that the district court failed to compare the plaintiff's work as a whole with Symantec's work as a whole.

It is difficult to even imagine the good-faith basis upon which Brown Bag asserts this argument since Brown Bag never asked the district court to compare the works as a whole and never offered the two programs in opposition to summary judgment so that such a determination could be made. Brown Bag's omissions constitute a waiver. (9th Cir.Opn. [App. A] p. 3739.)

B. Brown Bag's Limited Evidentiary Showing Was Insufficient to Meet its Burden on Summary Judgment.

In order to avoid summary judgment, Brown Bag was required to "come forward with all of [its] evidence," *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and make a showing sufficient to establish the essential elements on which it will bear the burden of proof at trial. *Id.* at 322. Brown Bag presented no such evidence to the district court. Its "evidence" consisted entirely of Mr. Ogg's list of allegedly similar features. Brown Bag did *not* offer copies of the actual programs so that they could be compared as wholes, and Mr. Ogg did not even refer to any exhibits. Lists of purported similarities are insufficient to demonstrate substantial similarity because "such lists . . . are inherently subjective and unreliable." *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984). Thus, Brown Bag's showing was inadequate on its face.

It would be absurd to suggest that, faced with Brown Bag's inadequate response, it was the duty of the district court to create a sufficient record on Brown Bag's behalf. Brown Bag neither asked the district court to engage in a comparison of the works as wholes nor provided the court with evidence from which anyone could conclude that the works in their entireties were substantially similar. The claim that the district court erred in failing to perform an analysis it was never asked to perform and for which Brown Bag provided no basis in the record can hardly constitute a basis for reversal.

Symantec's and Friend's comprehensive comparison of the two programs, offered in support of summary judgment, confirms that Brown Bag's decision not to place the programs into evidence was no oversight. The state of the record does not reflect any inadvertant evidentiary lacuna. Rather, Brown Bag preferred to try to make out its case based on a list of isolated, supposed similarities precisely because it was well aware that a more complete examination of the two programs would confirm that the user interfaces of the two programs are systematically and thoroughly different.

C. The Court "Carefully Reviewed" the Actual Programs and Sought to Consider Brown Bag's Claims in Context.

Notwithstanding Brown Bag's failure to provide the district court with any meaningful basis for considering Brown Bag's contentions, in an effort to place Brown Bag's list in an appropriate perspective the court did, *sua sponte*, direct the parties to demonstrate the programs at issue at the summary judgment hearing and to provide the court with copies of the programs that could be examined in chambers. We emphasize, however, that Brown Bag still did not provide a proper evidentiary basis for its claims and that the court's *sua sponte* action did not cure petitioner's failure to introduce evidence. The defect is not merely a technical one because, among other reasons, the authenticity of the materials used by Brown Bag in the demonstration was itself at issue.[11]

The district court stated that it had "carefully reviewed" the actual programs, using the Ogg list of features as a basis of comparison. (D.Ct.Opn. [App. B] pp. 1, 7) The Court methodically considered each feature alleged to be similar and concluded that all of the features on Brown Bag's list were either (1) different in the two programs, (2) expressly licensed to Friend, and/or (3) unprotectable under copyright. (*Id.* p. 14.)

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[11]There was a controversy at the summary judgment hearing over whether Brown Bag had "doctored" the color arrangements on the program used for its part of the presentation. (Docket Nos. 161 & 163.) Brown Bag never submitted authenticated copies of the actual programs as evidentiary exhibits nor did Brown Bag lay any foundation for admitting those copies into evidence. Hence, the programs at issue are in no way part of the record.

Contrary to Brown Bag's assertions, the court did, within the serious limits of Brown Bag's evidentiary showing, consider the entire programs and found no substantial similarity. The district court begins its opinion by stating that it was "called upon to decide whether the 'look and feel' of the screen displays" are substantially similar (D.Ct.Opn. [App. B] p. 1). Following its review of the functioning of all nine menus (essentially the entire user interface), the Court states its overall conclusion that "[t]he expression of the ideas inherent in the features [in GrandView] are . . . distinct" from PC-Outline (p. 10). And going beyond Brown Bag's limited paper showing of purported opening screen similarity, the Court "review[ed] the expression of that idea on the screen" and found that "no reasonable jury could find" the two actual screens to be substantially similar. (pp. 12-13.)

The district court's fact-finding concerning the differences in the user interfaces of the two programs was undisputed and is unimpeachable. It was and is uncontested that the menu structures and terminology of the two programs are different; that the opening screens are starkly different whether viewed element by element or as an entirety; that almost 90% of the keystroke shortcuts are different; and that three-quarters of the default color selections are different. (Docket No. 130, ¶¶ 26(a),(b),(e).) Even if the district court had some duty to examine the programs as wholes and even if it were shown that the district court failed to do so, reversible error still could not be shown because, on the undisputed facts, a comparison of the works in their entirety can only yield the conclusion that the works as a whole are different and that summary judgment was appropriate.

III.

SUMMARY JUDGMENT WAS REQUIRED BECAUSE THE UNCONTESTED RECORD SHOWS THAT GRANDVIEW AND PC-OUTLINE ARE NOT SUBSTANTIALLY SIMILAR.

On the uncontested record of facts which the defendants systematically and painstakingly assembled and put before the district court, any comparison of the works compels the conclusion that GrandView and PC-Outline are not substantially similar. If, as Brown Bag now argues, PC-Outline were treated as a

compilation, summary judgment is still plainly required because it is uncontested that the arrangement of elements is different in the two programs.

To establish copyright infringement, a plaintiff must prove that he owns a valid copyright and that the defendant copied the copyrighted work. *Sid & Marty Krofft Television Prod., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977). A *prima facie* case of "copying" is usually proven by circumstantial evidence — "access" by the defendant to the plaintiff's work and "substantial similarity" between the defendant's work and the plaintiff's work — but the *prima facie* case can be rebutted by evidence of independent creation of the accused work. *See, e.g., John L. Perry Studio, Inc. v. Wernick*, 597 F.2d 1308, 1309-10 (9th Cir. 1979). In this case "access" is not at issue.

A. The Scope of Brown Bag's Copyright Was Limited By Its Concessions Regarding Copyrightability.

It is axiomatic that copyright law protects only expression, not the ideas underlying that expression. 17 U.S.C. § 102(b); *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, ____ U.S. ____, 113 L.Ed.2d 358, 368 (1991); *Data East USA v. Epyx, Inc.*, 862 F.2d 204, 207 (9th Cir. 1988).

Copyright protection does not extend to an idea or even "to elements of expression that necessarily follow from the idea." *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987). This notion of "merger" between idea and expression affects the substantial similarity comparison:

> "To the extent that it is necessary to determine whether similarities result from unprotected expression, it is appropriate . . . to perform analytic dissection of the similarities."

Id. As the Ninth Circuit pointed out in this case, such analytic dissection is used, "not for the purpose of comparing similarities and identifying infringement, but for the purpose of defining the scope of plaintiff's copyright." (9th Cir.Opn. [App. A] p. 3738.) *Accord, Feist*, 113 L.Ed.2d at 371 ("The mere fact that a work is copyrighted does not mean that every element of the work may be protected."); *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600 (1st Cir. 1988); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2nd Cir. 1980).

Indeed, in another case involving allegedly similar computer screen displays, the Ninth circuit held that "it was clear error for the District Court to determine that protectable substantial similarity existed" based upon "similarities result[ing] from unprotectable expression." *Data East*, 862 F.2d at 209. "The lower court erred by not limiting the scope of Data East's copyright protection to the author's contribution . . . ." *Id.*; *accord, Frybarger v. IBM Corp.*, 812 F.2d 525, 529-30 (9th Cir. 1987).[12]

Under the controlling copyright authority in the Ninth and other Circuits, then, the trial court was required in making its "substantial similarity" analysis to determine whether each allegedly similar feature constituted copyrightable subject matter and to compare only features in the two programs constituting copyrightable subject matter.

> "What is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectible expression in [the accused work] is substantially similar to the equivalent portions of [the plaintiff's work]."

Cooling Systems & Flexibles v. Stuart Radiator, 777 F.2d 485, 493 (9th Cir. 1985).

Turning to our case, Brown Bag never disputed in the district court that the only elements of GrandView that were similar to PC-Outline were unprotected or unprotectable subject matter. Likewise on appeal, Brown Bag did not take issue with the lower court's conclusion that the only similarities between the two programs were uncopyrightable functions or licensed features. In the Ninth Circuit, as here, Brown Bag's sole substantive argument was that PC-Outline as a whole could be nonetheless protectable as a compilation.

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[12]In a number of cases involving artistic works such as greeting cards, courts have not required excission of noncopyrightable elements. *See, e.g., Roulo v. Russ Berrie & Co.*, 886 F.2d 931 (7th Cir. 1989), and *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970). The computer outlining programs at issue here are not artistic works, however, and the standard of *Roulo* and *Roth* are inapposite by their own terms.

For the reasons stated in the previous Argument, Brown Bag is barred from contending that the district court erred by failing to compare the works as a whole. Even were that not so, however, Brown Bag's compilation claim cannot withstand scrutiny because Brown Bag cannot show "bodily appropriation" of the arrangement of elements of its interface.

B. Brown Bag Cannot Meet the Standard For Infringement of Compilations.

Doubtless, the selection, coordination and arrangement of noncopyrightable elements may in some cases qualify for copyright protection as a "compilation." 17 U.S.C. § 103(a); *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197 (9th Cir. 1989). But the copyright in a compilation is "thin," and "the copyright is limited to the particular selection or arrangement." *Feist*, 113 L.Ed.2d at 371, 372. "Even if a work qualifies as a copyrightable compilation, it receives only limited protection." *Feist* at 377.

That protection does not "imply any exclusive right in the preexisting material," as opposed to the arrangement itself. 17 U.S.C. § 103(b). Moreover, "copyright infringement of compilations consisting largely of uncopyrightable elements should not be found in the absence of '*bodily appropriation* of expression.'" *Harper House* at 205 (emphasis added).

Here, the selection and arrangement of noncopyrightable elements were dictated largely by the requirements of outlining itself. (Docket No. 122, Exh. A, pp. 30-31, 39-43.) More importantly, it is uncontested that GrandView's selection and arrangement of those elements is *different* from PC-Outline's: The selection, arrangement and titles of GrandView's menus were demonstrated (and admitted) to be different from PC-Outline's, as were the programs' opening screens, 90% of the keystroke shortcuts and three-quarters of the default color selections. (Docket No. 130, ¶¶ 26(a),(b),(e).) If PC-Outline constituted a copyrightable "compilation" of noncopyrightable elements, Brown Bag would have no interest in the pre-existing elements of the compilation as opposed to the arrangement itself. 17 U.S.C. § 103(a); *Feist*. Since the arrangement is admittedly very different in Symantec's Grandview, and there has therefore been no "bodily appropriation" of Brown Bag's arrangement, Brown Bag

has no claim for relief. *Harper House* at 205 (bodily appropriation requires substantially identical copying of the entire item). Hence, even if the district court had somehow erred by failing to compare the two works "as wholes" and if PC-Outline were protectable as a compilation, on the undisputed facts Brown Bag's arrangement of elements was not infringed by GrandView.

CONCLUSION

Brown Bag's contentions on appeal and here are mere afterthoughts with no merit. Brown Bag's discovery claim is frivolous, and, on the uncontested facts, its copyright arguments are insubstantial. Brown Bag presents no issue worthy of this Court's attention. Symantec respectfully requests that certiorari be denied.

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